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Attorney Docket # 5253-25

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Rolf MINTGEN et al.
Serial No.: 10/627,326
Filed: July 25, 2003
For: Piston-Cylinder Unit

Examiner: Robert Siconolfi
Group Art: 3683

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**RESPONSE TO REQUIREMENT FOR ELECTION
OF SPECIES/RESTRICTION**

SIR:

Responsive to the restriction requirement in the Office Action of July 14, 2004, Applicants hereby elect Species A (Figure 1) for prosecution on the merits, for the event that no generic claim is finally held to be allowable.

Claims 1-7, 9-10, 18 and 20 read on the embodiment shown in Figure 1.

Pursuant to the requirement to elect a subspecies, Applicants hereby elect subspecies A (Figures 16-17). Claim 19 reads on this subspecies.

Pursuant to the further requirement to elect a subspecies, Applicants hereby elect subspecies AA (Figure 25). Claim 8 reads on this subspecies.

The restriction requirement is traversed for the reasons following. In order for a restriction requirement to be proper, 35 U.S.C. § 121 requires that two or more independent AND distinct inventions be claimed in a single application. Thus, more is necessary to support a restriction requirement than a showing that two or more disclosed subjects are patentable over each other (distinctness).

The term "independent" (i.e., not "dependent") means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example, species under a genus *which species are not utilizable together as disclosed*. See MPEP 802.01.

Turning now to the embodiments disclosed in the application, Figures 2-15 illustrate various arrangements which could be used in conjunction with the feature shown in Figure 1. For example, the magnet arrangement of Figure 11 can be used with the spring 18 of Figure 1. Likewise, the latching arrangement of Figure 13, the snap ring 49 of Figure 14, and the compression spring 51 could be used with the features of Figure 1. So none of these figures represents species which are independent of the species in Figure 1.

Figures 16-17, on the other hand, show embodiments which are exclusive of the features shown in Figure 1, whereas Figures 18-24 are consistent insofar as they show the flaps 26, 27 of Figure 1 (claim 20).

Figures 25-33 all depict slide valves (claim 8), which are mutually exclusive of the features of Figure 1, which depicts a seat type valve (claim 7). The requirement to elect one of the subspecies AA-II therefore creates a conflict with Applicants' desire to elect the valve seat arrangement shown in Figure 1.


Based on the foregoing, it is felt that the restriction requirement is at least partially improper and should be withdrawn, so that all claims are considered. This is not believed to present any undue burden in view of the fact that many embodiments are not specifically claimed, e.g. the various slide valves of Figures 25-33 are all covered by claim 8.

Early action on the merits is solicited.

Applicants reserves the right to pursue the non-elected claims in a divisional application prior to issuance of a patent on the instant application.

Any additional fees or charges required at this time in connection with the application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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